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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,902	07/28/2006	Takashi Sato	2006_1189A	3590

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EXAMINER
KASHNIKOW, ERIK

ART UNIT	PAPER NUMBER
1782	

NOTIFICATION DATE	DELIVERY MODE
08/04/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/587,902	SATO ET AL.	
	Examiner	Art Unit	
	ERIK KASHNIKOW	1782	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 June 2010*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9 and 15-17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9 and 15-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *07/23/10*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-9 and 15-17 rejected under 35 U.S.C. 103(a) as obvious over Nakajima et al. (JP 2003-136657 with US 2005/0011892 used as a translation).

3. In regards to claims 1 and 3 Nakajima et al. teach a hollow container comprising a polyglycolic acid layer (hereinafter PGA) that has a gas barrier property (paragraph 0001). Nakajima et al. teach that the PGA comprises at least 60 wt% of the instant claimed recurring unit (paragraphs 0017 and 0018). Nakajima et al. further teach that the container may comprise additional co-laminated layers that comprise either an aromatic polyester or an aliphatic polyester (paragraphs 0046-0047). While Nakajima et al. is silent with regards to the satisfying the instantly claimed formula it has been shown that absent a showing of criticality with respect to "volume of the container as well as weight content of the PGA with regards to the entire container" (result effective variables), it would have been obvious to a person of ordinary skill in the art at the time of the invention to adjust the "volume of the container and the concentration of the PGA" through routine experimentation to values, including those presently claimed in order to

achieve "a container of the desired size with the desired gas barrier, properties heat resistance and mold workability". It has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). It is further noted that Nakajima et al. teach that the gas barrier property may be improved by including another PGA layer, or varying the thickness of said layer (paragraph 0081). As all of these are result effective variables it would have been obvious to a person of ordinary skill in the art at the time of the invention to adjust these variables through routine experimentation in order to form a container of a desired size and gas barrier property which would also satisfy the equation set forth in the instant claim. It is noted that in paragraph 0148 Nakajima et al. teach that the parison could be used using a cold or a hot parison method. One of ordinary skill in the art would recognize that a cold parison method is one wherein the parison is heated cooled then heated and co stretched.

4. In regards to claim 2 Nakajima et al. teach that the other polyester layer may comprise polylactic acid, which has a glass transition temperature of 53^{o}C (paragraph 0051).

5. In regards to claims 4 and 16 as stated above Nakajima et al. teach that an aromatic polyester layer and an aliphatic polyester material may be used as the thermoplastic polyester layer of Nakajima et al. Further Nakajima et al. teaches that the polyester layers may sandwich the PGA layer and do not have to comprise the same material, which would include embodiments wherein an aliphatic polyester and an aromatic polyester are both used (paragraph 0078-0080).

6. In regards to claims 5 and 16 Nakajima et al. further teach that the layers are laminated to one and other and then co-stretched (paragraph 0100-0102).

7. In regards to claim 6 Nakajima et al. teach an embodiment wherein an aromatic polyester is laminated on both sides of the PGA layer (table 1 and paragraph 0136).

8. In regards to claim 7 Nakajima et al. teach that the thermoplastic polyester layer may also comprise a regrind (recycled) resin (paragraph 079).

9. In regards to claim 8 it is noted that Nakajima et al. do not disclose any PGA in the regrind resin, but further it has been shown that absent a showing of criticality with respect to "concentration of PGA in the regrind" (a result effective variable), it would have been obvious to a person of ordinary skill in the art at the time of the invention to adjust the "concentration of PGA in the regrind" through routine experimentation to values, including those presently claimed in order to achieve "the optimal gas barrier property of said layer". It has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

10. One of ordinary skill in the art at the time of the invention would be motivated to use the cold parison forming method of Shiiki et al. in the invention of Nakajima et al. because Shiiki et al. offers improved

Response to Arguments

11. Applicant's arguments see arguments, filed 06/03/10, with respect to the objection of the abstract and the claims have been fully considered and are persuasive. The objections of the abstract and the claims have been withdrawn.

12. In response to Applicant's arguments that weight and volume of said containers as result effective variables, it has been found that "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. (MPEP 2144.05 II)". On of ordinary skill in the art would recognize that oxygen permeability is a function of the speed oxygen travels through a material and therefore it is obvious to adjust the concentration of a compound to achieve a desired oxygen gas permeability, as more or less of specific compounds will in and of itself adjust the permeability of the final container. Further, generally, differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. Further one of ordinary skill in the art would recognize that for a container the amount of oxygen that permeates in to or out of said container will depend on the volume/surface space of the container, as in most instances a larger volume of a container will result in more area through which oxygen can permeate into and out of said container and therefore effecting the oxygen permeability of said container.

13. In response to Applicant's arguments regarding the newly added process limitation Examiner points out that the courts have ruled that "applicant must look to the whole reference for what it teaches. Applicant cannot merely rely on the examples and

argue that the reference did not teach others." In re Courtright, 377 F.2d 647, 153 USPQ 735,739 (CCPA 1967). It is noted that the rejection has been amended to specifically point out where the prior art teaches the new limitation.

14. It is noted that the paragraph numbers of the rejection have been changed to correspond with US 2005/0011892.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ERIK KASHNIKOW whose telephone number is (571)270-3475. The examiner can normally be reached on Monday-Friday 7:30-5:00PM EST (Second Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Erik Kashnikow
Examiner
Art Unit 1782

/Rena L. Dye/
Supervisory Patent Examiner, Art Unit 1782